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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,044	03/16/2005	Petrus Besselink	BES 0009 PA	2774
23368 7590 03/10/2009 DINSMORE & SHOHL LLP ONE DAYTON CENTRE, ONE SOUTH MAIN STREET SUITE 1300 DAYTON, OH 45402-2023				
EXAMINER				
HOUSTON, ELIZABETH				
ART UNIT		PAPER NUMBER		
3731				
MAIL DATE		DELIVERY MODE		
03/10/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/528,044

Applicant(s)

BESSELINK, PETRUS

Examiner

ELIZABETH HOUSTON

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-74 is/are pending in the application.
- 4a) Of the above claim(s) 7, 11, 12, 14, 22-40, 43-47, 49, 50, 53, 54 and 60-74 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-10, 13, 15-21, 41, 42, 48, 51, 52 and 55-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 091806.061705
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, species b (Figures 33-39) in the reply filed on 12/05/08 is acknowledged. Elected claims include 1-6, 8-10, 13-23, 42, 51, 52, 55-59. However, upon further evaluation, examiner has determined that claims 14, 22 and 23 are directed toward a non-elected embodiment. Furthermore, claim 42 is dependent from claim 41, which should have been included as corresponding to the elected embodiment. Claims 51 and 52 are dependent from claim 48, which also should have been included as corresponding to the elected embodiment. Therefore, claims 1-6, 8-10, 13, 15-21, 41, 42, 48, 51, 52 and 55-59.
2. Claims 7, 11, 12, 14, 22-40, 43-47, 49, 50, 53, 54 and 60-74 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/05/08.

Claim Objections

3. Claim 5 objected to because of the following informalities: Claim 5 recites the limitation "membrane unit" in line 2. There is insufficient antecedent basis for this limitation in the claim. For the purposes of examination, the limitation will be read as being directed to "a membrane" in claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5, 8, 9, 13, 15, 18-21, 41, 42, 48, 51, 52 and 55-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsugita (US 6,371,064) in view of Gianotti (US 5,836,962).

6. Tsugita discloses a medical device configured to be disposed within a body lumen, said device comprising: a membrane (25); further comprising a frame (22) attached to said composite structure to hold said membrane in a desired shape, said frame comprising a proximal end (111) and a distal end (112); further comprising an elongated member (30) configured to transport said device to an appropriate location in said body lumen; wherein said elongated member comprises a guide wire attached to at least one of said frame or said composite structure (Fig. 4c); wherein said proximal end of said frame is remote from said membrane unit (Fig. 4c); further comprising a plurality of slide rings (111, 112), each of said slide rings connected to opposing ends of said device such that said slide rings are responsive to displacement forces imparted thereto by said guide wire; wherein said frame is configured to allow said guide wire to move freely in axial, radial, tangential and rotational directions within said frame when said frame is in an expanded state without influencing the position and shape of said device

(C2:L58-63); wherein said frame has elongated struts (181) that define attachment points at said proximal end to facilitate connection of said frame to said guide wire (Fig. 16a); further comprising a hollow tube (10) advance able into a region at least partially enclosed by said composite structure when said composite structure is in an open state and said guide wire is configured to fit within said hollow tube (C10:L40-55); said tube is configured to perform at least one of a suction, flushing, inspection, measuring, clot-breaking, and retrieval device introduction functions while said tube is advanced into said at least partially enclosed region (angioplasty C10:L45); said hollow tube is dimensioned to serve as a removal sheath for said device; wherein said composite structure is a filter that is expandable into an expanded state, said filter comprising a substantially closed distal end and an open proximal end such that said filter tapers from said proximal end to said distal end (Fig. 16a); further comprising a reservoir (defined by membrane 22) in said filter that extends from said distal end, said reservoir defining a debris storage space; and a plurality of stops (167, 168; C14:L53-57) affixed to said guide wire such that upon contact between one of said stops and one of said first or second rings due to movement of said elongated member, said device moves either into or out of said body lumen.

7. Tsugita does not disclose reinforcement fibers coupled to the membrane. However Gianotti discloses a mesh that incorporates reinforcement fibers (4). It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate reinforcement fibers into the membrane of Tsugita to provide tensile strength with flexural rigidity as taught by Gianotti. The membrane would be coupled to

first and second fibers as taught by Gianotti, which in turn would be coupled to the guidewire as taught by Tsugita. The frame would be attached to said composite structure through said reinforcement fibers. The material making up said first and second fibers is the same. The reinforcement fibers are discontinuous (since there are multiple fibers) and dispersed throughout said membrane (Fig. 3). The reinforcement fibers being part of the filter membrane would be directly attached to one of said slide rings and said distal end of said frame.

8. Claims 6, 10, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsugita in view of Gianotti as applied to claims above, and further in view of Daniel (US 5,814,064).

9. Tsugita modified by Gianotti does not disclose that which is taught by Daniel. Daniel teaches a filter device that comprises pulling fibers (222) connecting said proximal end of said frame to said guide wire (indirectly) to enable said device to be retracted into a removal sheath by a pulling force on said guide wire in order to retrieve said device from said body lumen (C9:L64-C10:L2). The fibers are connected to attachment points by means of attachment holes (220) disposed therein.

10. As to claim 17, Daniel teaches a fiber connected to attachment points but is silent as to how the fibers are attached. The claimed phrase "by gluing or welding" is being treated as a Product by Process limitation that is that the fibers are attached by the process of gluing or welding. As set forth in the MPEP 2113, "Even though product-by-process claims are limited by and defined by the process, determination of patentability

is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted) (See MPEP § 2113). Examiner will thus evaluate the product claims without giving much weight to the method of its manufacture.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH HOUSTON whose telephone number is (571)272-7134. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. H./
Examiner, Art Unit 3731

/Anh Tuan T. Nguyen/
Supervisory Patent Examiner, Art Unit 3731